

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: March 19, 2003

Paper No. 25
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Control Fire Systems Ltd.

Serial No. 75/525,647

James W. McKee and Colleen F. Goss of Fay, Sharpe, Fagan,
Minnich & McKee, LLP for Control Fire Systems Ltd.

Melissa Shella, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Chapman, Bucher and Bottorff, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Control Fire Systems Ltd. (a Canadian corporation)
seeks to register on the Principal Register the mark shown
below



for services ultimately amended to read as follows:

"installation and repair of fire suppression systems and consultation related thereto; repair services for hydrofluorocarbon equipment and halon recycling equipment" in International Class 37; and

"recycling of halon" in International Class 42.¹

Applicant disclaimed the words "FIRE SYSTEMS LTD."; and included the following statement: "The lining and stippling shown in the drawing are features of the mark and are not meant to indicate color." The application is based on Sections 44(d) and (e) of the Trademark Act, 15 U.S.C. §1126(d) and (e), and applicant's two Canadian Registration Nos. 522,365 and 533,178, which issued from applications filed April 1, 1998 and June 24, 1998², respectively.³

The Examining Attorney has refused registration of applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the basis of Registration No. 2,084,281, which issued July 29, 1997 on the Principal Register for the mark CONTROL for "fire and/or burglar

¹ Application Serial No. 75/525,647, filed July 27, 1998.

² In light of the services set forth in Canadian Registration No. 522,365 as compared to the services set forth in Canadian Registration No. 533,178, the Board notes that only the latter registration (filed June 24, 1998 in Canada) covers all of the services involved in this United States application.

³ The original application also included applicant's assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). However, on September 14, 2001 applicant filed a paper specifically deleting that basis for registration.

alarm installation maintenance and/or repair" in International Class 37.⁴

When the refusal to register was made final, applicant appealed. Both applicant and the Examining Attorney have filed briefs. Applicant requested an oral hearing, but subsequently waived its request.

Preliminarily, we note the record is not a model of clarity regarding whether the Examining Attorney was refusing registration as to both classes of services in this application on the basis of the cited registration. Applicant paid the appeal fee for two classes of services. While there is no question that both applicant and the Examining Attorney focused on the "installation and repair of fire suppression systems" portion of applicant's identification of services in International Class 37, the Board, in order to provide a complete decision, will also determine the issue of registrability of the mark as to applicant's International Class 42 services.

We turn to the refusal to register on the ground of likelihood of confusion, which we consider in light of the Court's guidance in *In re E. I. du Pont de Nemours & Co.*,

⁴ The cited registration also includes "locksmithing services" in International Class 42, but the Examining Attorney did not cite that class or argue a refusal with regard thereto.

476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

The Examining Attorney contends that the dominant portion of applicant's mark is the word CONTROL; that the descriptive and disclaimed words "fire systems ltd." and the design of a fire flame in applicant's mark are less significant portions of applicant's mark, both reinforcing the nature of applicant's services of installing and repairing fire suppression systems, and will be so perceived by the purchasing public; that the connotation of both marks is that of restraining or managing a fire; that both applicant's mark and the cited registrant's mark, considered in their entirety, create similar commercial impressions; that the third-party applications and registrations submitted by applicant are not persuasive because several are abandoned or expired, and because those remaining are for goods and/or services not as closely related as are the cited registrant's and applicant's services and the third-party marks generally create very distinct commercial impressions different from that involved herein; that applicant's services of "installation and repair of fire suppression systems" are closely related to the cited registrant's services of "fire and/or burglar

alarm installation, maintenance and/or repair"; that these services are complementary services, often used together by consumers; that these respective services, as identified, do not include restrictions as to the channels of trade or purchasers; that applicant's extrinsic evidence regarding both its and the cited registrant's services is of little probative value in this regard (e.g., the two-page printout identified by applicant as being from the cited registrant's website does not include the cited registrant's address in New York and, in any event, mentions various locks and locking systems but does not mention fire alarm systems); and that even if it is presumed that the purchasers of at least applicant's services are sophisticated, such purchasers would not be immune from confusion as to the source of such related services sold under similar marks.

Applicant, on the other hand, argues that when considered in their entirety, the marks create different commercial impressions as applicant's mark includes the words "fire systems ltd." and the design of a flame which is an integral part of the mark, while registrant's mark is the word CONTROL with no other features; that the Examining Attorney has improperly dissected applicant's mark in analyzing the similarities/dissimilarities between the

involved marks; that when considering the marks in their entirety, the additional descriptive wording and the flame design in applicant's mark must be taken into account; that there is no rule that likelihood of confusion is automatically found if an applicant seeks to register a mark that contains the whole of another mark; that the relative strength of the cited mark must be considered and applicant submitted photocopies of several third-party applications and registrations including the word CONTROL or CONTROLS establishing that the cited mark is weak and entitled to a narrow scope of protection; that the involved services are not closely related as applicant has shown that its services are "sophisticated fire suppression systems," whereas the cited registrant's services are "simply burglar and fire alarm installation and repair" (brief, p. 9); that the price and technical nature of applicant's services show that a high degree of care and attention will be used when purchasing applicant's services; that the sophistication of buyers cannot be ignored and even if the consumers are deemed to be unsophisticated, there must be a lower limit on the carelessness of the reasonable purchaser; and that there must be a likelihood of confusion, not just a possibility of confusion.

Turning first to a consideration of the involved marks, it is well settled that marks must be considered in their entireties as to the similarities and dissimilarities thereof. However, our primary reviewing court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

In this case, both applicant's mark and registrant's mark share the word CONTROL. It is the cited registrant's entire mark, and it is the dominant part of applicant's mark. The words "FIRE SYSTEMS LTD." are descriptive or non-trademark significance words, and they are the remaining words in applicant's corporate name. (In response to an Office requirement that applicant disclaim these descriptive words, applicant did so.) The design of a fire flame as part of a mark used to identify the source

of fire suppression system installation and repair services is hardly unique. Moreover, the word "CONTROL" appears in much larger lettering, further emphasizing its dominance.

We agree with the Examining Attorney that the word CONTROL connotes the same thing for both applicant's installation and repair of fire suppression system services and registrant's installation, maintenance and repair of fire and burglar alarms. That is, the connotation of the dominant word in applicant's mark is very similar to that of registrant's mark, specifically, the restraining or managing of a fire through the use of the services offered by applicant and registrant respectively.

Moreover, applicant's submission of photocopies of several third-party applications and registrations⁵ to show that the term "control" is weak in the relevant field of providing installation, maintenance and repair of fire alarms or fire suppression systems is not persuasive. Third-party applications are evidence only that the applications were filed on their respective filing dates. Third-party registrations are of little weight in our

⁵ Applicant submitted one additional application and one additional registration with its brief on appeal. Although these are untimely pursuant to Trademark Rule 2.142(d), the Examining Attorney did not object thereto and argued the merits thereof. Thus, the Board considers these two additional pieces of evidence are stipulated into the record.

determination of likelihood of confusion as they are not evidence of use of the marks shown therein and they are not proof that consumers are familiar with them so as to be accustomed to the existence of similar marks in the marketplace. With regard to the weight given to third-party registrations, the Court of Appeals for the Federal Circuit stated in the case of *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992):

Under *Du Pont*, "[t]he number and nature of similar marks in use on similar goods" is a factor that must be considered in determining likelihood of confusion. 476 F.2d at 1361, 177 USPQ at 567 (factor 6). Much of the undisputed record evidence relates to third party registrations, which admittedly are given little weight but which nevertheless are relevant when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given any weight. *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them. ...") (Italics emphasis in original.)

In the case now before us, there is no evidence of record regarding the existence of any third-party uses of marks consisting of or including the term CONTROL for the

involved services or any relevant or related services; and third-party registrations cannot be given any weight with regard to the strength of the mark.

To the extent these third-party registrations are considered generally with regard to the issue of likelihood of confusion, they do not obviate the likelihood of confusion because they do not show use of marks which are as similar as applicant's and the cited registrant's marks, nor do they cover services as closely related as applicant's and the cited registrant's. That is, the third-party registrations create different and distinct commercial impressions and do not generally cover the services involved herein.⁶

⁶ See, for example, Registration No. 2,418,862 issued under Section 2(f) for the mark WILLIAMS FIRE & HAZARD CONTROL (FIRE & HAZARD CONTROL disclaimed) for "distributorship and catalog sales services in the field of industrial fire fighting and fire protection systems, equipment, and supplies" in International Class 35; Registration No. 1,840,198 issued for the mark CONTROL-A for "foaming agent to assist in the extinguishing of fires" in International Class 6; Registration No. 1,317,768 issued for the mark ARGUS FIRE CONTROL (FIRE CONTROL disclaimed) for "fire extinguishers, infrared fire detectors and control panels therefore" in International Class 9; Registration No. 1,046,339 (now expired) issued for the mark CONTROL DATA CORPORATION (in stylized lettering and design) (CORPORATION disclaimed) for a wide variety of goods and services, including "insurance underwriting services in the fields of health, life, disability and fire insurance" in International Class 36; and Registration No. 1,090,088 issued under Section 2(f) for the mark JOHNSON CONTROLS (in stylized lettering) (CONTROLS disclaimed) for "installation, servicing and maintenance of heating, ventilating, and air conditioning equipment, of surveillance, fire detection, and standby power equipment, and of key-operated signal

In any event, while the United States Patent and Trademark Office strives for consistency, each case must be decided on its own facts and record. Of course, we do not have before us any information from the third-party application or registration files. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Assuming applicant had established that the cited registered mark is weak (which applicant has not done), even weak marks remain entitled to protection against registration by a subsequent user of the same or similar mark for the same or related services.⁷

Under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks. See *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). The differences in the marks (applicant's addition of the

generators for use with teletype equipment" in International Class 37.

⁷ We specifically note that the cited registered mark is on the Principal Register with no claim of acquired distinctiveness under Section 2(f) of the Trademark Act; and it is, of course, entitled to the statutory presumptions under Section 7(b).

words "fire systems ltd." and a flame design) do not serve to distinguish the marks here in issue. That is, purchasers are unlikely to remember the specific differences between the marks, focusing more on the word CONTROL, due to the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. Purchasers seeing the marks at separate times may not recall these differences between the marks. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

Applicant strongly urges that the cases of *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992), and *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986), require a different result in the case now before the Board due to the differences in the marks and the services. However, the Court explained in the Hearst case at 25 USPQ2d 1239 that "the weight given to the respective words is not entirely free of subjectivity... ." And in the Bed & Breakfast Registry case, both marks shared certain words ("bed & breakfast"), but both marks also included another word ("registry" or

"international") and the Court explained that travelers would rely on the noncommon portions of the marks to distinguish there between.

We disagree with applicant that the Hearst case and the Bed & Breakfast Registry case require a different result herein because there is no second word in the cited registrant's mark, and we have given each element of applicant's mark appropriate weight and, of course, we have ultimately considered the similarities/dissimilarities of the marks in their entirety.

We find that applicant's mark CONTROL FIRE SYSTEMS LTD. and design and registrant's mark CONTROL, when considered in their entirety, although obviously not identical, are very similar in sound and connotation, somewhat similar in appearance, and create similar overall commercial impressions. See *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Turning to the similarities/dissimilarities and the nature of the involved services, the Board must determine the issue of likelihood of confusion on the basis of the goods and/or services as identified in the application and the registration, and in the absence of any specific limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such

goods. See Octocom Systems Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1034, 216 USPQ 937 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76 (CCPA 1973).

As explained earlier herein, the record from both applicant and the Examining Attorney is directed solely to the portion of applicant's International Class 37 services identified as "installation and repair of fire suppression systems" vis-a-vis registrant's identified services, which are "fire and/or burglar alarm installation, maintenance and/or repair" in International Class 37. We will consider the cited registrant's services vis-a-vis both of applicant's classes of services.

It is well settled that goods or services need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under

circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

The cited registrant's installation, maintenance and repair of fire alarms and the portion of applicant's services in International Class 37 identified as the installation and repair of fire suppression systems are complementary, closely related services. Applicant's original application included goods in International Class 9 such as "fire alarm systems and associated devices" and "detection and control equipment," and the original International Class 37 services included "installation, servicing, and consulting, with respect to fire detection/suppression systems, alarm systems, and equipment." Applicant's first proposed amended identification of services included "installation and repair of fire alarm, fire detection and suppression systems...." In addition, applicant's Canadian registrations include goods and services relating to fire alarms. The complementary nature of fire alarm and fire suppression services is obvious and cannot be ignored. See *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*. The

record establishes that at least this item in applicant's International Class 37 services is closely related to the services set forth in the cited registration.

Neither registrant's services, nor applicant's services relating to fire suppression systems, as identified, are restricted as to uses or trade channels or purchasers. Thus, applicant's argument that its fire suppression system services are sold to sophisticated purchasers, while registrant's services involve simply fire/burglar alarms systems, which are not viewed by the same consumers is unpersuasive. First, there is no restriction to the channels of trade or purchasers in the involved portion of applicant's International Class 37 services, nor in the registration. Second, even if the consumers of applicant's fire suppression systems are viewed as sophisticated, the registrant's fire/burglar alarm system services would be offered to the general public which certainly includes those sophisticated purchasers of applicant's services. Even if we assume that the purchasers of the services in question in the instant case are sophisticated purchasers, and that the purchase of the respective services is done after careful consideration, this does not mean that such purchasers are immune from confusion as to the origin of the respective

services, especially when sold under similar marks. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). That is, even relatively sophisticated purchasers and users of these installation and maintenance and repair of fire alarm services or fire suppression system services, could believe that these services come from the same source, if offered under substantially similar marks. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, footnote 17 (TTAB 1992).

In this case, applicant's International Class 37 fire suppression system services and the fire alarm services of the registrant could be encountered by purchasers in circumstances that would give rise to the belief that both parties' services come from or are associated with the same source. See *Dan Robbins & Associates, Inc. v. Questor Corporation*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979). We find that the record sufficiently establishes the relatedness between these services.⁸

⁸ It is not necessary that a likelihood of confusion be found as to each item included within one class in an applicant's identification of goods or services. See *Squirtco v. Tomy Corporation*, *supra*; *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); and *Alabama Board*

Considering all of the relevant du Pont factors, we conclude that consumers familiar with registrant's fire alarm installation, maintenance and repair services offered under the mark CONTROL would be likely to believe, upon encountering applicant's mark, CONTROL FIRE SYSTEMS LTD. and design, for fire suppression system installation and repair services, that both originated with or were somehow associated with or sponsored by the same entity.

With regard to applicant's International Class 42 services -- "recycling of halon," this ex parte record does not establish any relatedness of these services to those of the cited registrant.

Decision: The refusal to register under Section 2(d) is affirmed as to applicant's International Class 37 services; and the refusal to register under Section 2(d) is reversed as to applicant's International Class 42 services. (In due course, the application file will be forwarded to the Examining Attorney for appropriate action in approving the application for publication on the International Class 42 services.)

of Trustees v. BAMA-Werke Curt Baumann, 231 USQP 408, footnote 7 (TTAB 1986). Thus, we need not find (and we acknowledge the record does not support) relatedness of applicant's "repair services for hydrofluorocarbon equipment and halon recycling equipment" in International Class 37 and the services identified in the cited registration.